

REMARKS

Claims 1-3, 6, 8, 9, 14, 17, 22, 28-34, 36-42, 45-54, and 56-64 are the currently pending, non-withdrawn claims in this application. None of these claims are amended by this Response.

In the Office Action, claims 49, 50, 52-54, and 57-59 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. Des. 175,510 to Katz ("Katz"), claims 1-3, 6, 8, 9, 14, 22, 28-34, 36-42, 45-48, and 61-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz, and claims 1-3, 6, 8, 9, 14, 22, 28-34, 36-42, 45-54, 56-59, and 61-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,459 to Ignatowski ("Ignatowski").

Applicants thank the Examiner for identifying the allowable subject matter of claims 17 and 60. Applicants have not placed claim 17 in independent form because, as discussed below, its base claim 1 is patentable.

Rejection Under 35 U.S.C. § 102

Applicants respectfully traverse the rejection of independent claims 49 and 54 as being anticipated by Katz. Claims 49 and 54 recite, among other things, an elongated body portion disposed between the proximal end piece and the distal end piece, the elongated body portion further comprising a non-loop segment connected to a plurality of interconnected loops.

Katz, however, does not disclose or suggest a non-loop segment connected to a plurality of interconnected loops. The Examiner cites Katz, Figure 1, as teaching a necklace, or the like, with a "central ring" and "body chain links." The Office Action does not point to any structure of Katz as teaching a non-loop segment. In fact, there is no disclosure by Katz of a non-loop segment. As illustrated in Figure 1 of Katz, for example, the central ring appears to be comprised of at least three different loops. Moreover, Katz is a design patent and, thus, does not include any text characterizing the center component as a non-loop segment. Therefore, because Katz fails to disclose a non-looped segment connected to a plurality of interconnected loops, Applicants respectfully request that the Examiner withdraw the Section 102 rejection.

Claims 50, 52, 53, and 57-59 depend directly or indirectly from independent claims 49 and 54, and are therefore allowable for at least the same reasons stated above regarding claims 49 and 54. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Rejection Under 35 U.S.C. § 103

A. Rejection In View of Katz

Applicants respectfully traverse the rejection of independent claims 1, 22, 36, 61, and 62 as being obvious in view of Katz. The Examiner has failed to establish a prima facie case of obviousness because the Examiner has not shown that Katz either (1)

teaches all the present claim limitations; (2) suggests a motivation for one of ordinary skill in the art to modify their teachings to make the claimed invention; or (3) provides one of ordinary skill with a reasonable expectation of success in modifying their teachings. See M.P.E.P. §§ 2143.01, 2143.02, & 2143.03.

The Examiner states that Katz discloses the claimed invention “with the exception of the end pieces being larger in diameter than the rest of the body” and that it would be an “obvious aesthetic design choice.” (Office Action, p. 5). Applicants respectfully disagree. Claims 1, 22, 36, 61, and 62 recite, among other things, a “substantially cylindrical non-loop segment” connected to at least one of a plurality of interconnected loops. Katz does not disclose this element of the claimed invention. As described above, Katz teaches a necklace, or the like, with a central ring and body chain links, none of which comprise a “substantially cylindrical non-loop segment.”

Additionally, as the Examiner has conceded, Katz does not disclose that the end pieces are larger in diameter than the rest of the body. The Examiner alleges “that making the central ring somewhat smaller in size than the two end spheres would have been a mere obvious aesthetic design choice, as the ring would not behave any differently, in the smaller size.” (Office Action, p. 5). Applicants respectfully disagree. Katz does not expressly disclose that the smaller size central ring would not behave any differently, and the Examiner does not point to any such express teaching in Katz. In

particular, making the central ring of Katz smaller may prevent the attachment of the body chain links, thus destroying the functionality of the Katz necklace. Accordingly, making the central ring of Katz smaller would not have been an obvious design choice, nor would one skilled in the art have arrived at the claimed device after considering the scope and content of Katz. Reconsideration is respectfully requested.

Claims 2, 3, 6, 8, 9, 14, 28-34, 37-42, 45-48, 63 and 64 depend directly or indirectly from independent claims 1, 22, and 36, and are therefore allowable for at least the same reasons stated above regarding claims 1, 22, and 36. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

B. Rejection In View of Ignatowski

Applicants respectfully traverse the rejection of independent claims 1, 22, 36, 49, 54, 61, and 62 as being obvious in view of Ignatowski. The Examiner has failed to establish a prima facie case of obviousness because the Examiner has not shown that Ignatowski either (1) teaches all the present claim limitations; (2) suggests a motivation for one of ordinary skill in the art to modify their teachings to make the claimed invention; or (3) provides one of ordinary skill with a reasonable expectation of success in modifying their teachings. See M.P.E.P. §§ 2143.01, 2143.02, & 2143.03. Each

independent claim, requires, among other things, spherical end pieces, whose diameter is larger than a diameter of the remainder of the device.

The Examiner states that Ignatowski discloses the claimed invention with the exception that “the end pieces are not spherical or larger in diameter than the rest of the body ” and that, “by making connector 40 smaller in size than the end pieces would have been a mere obvious design choice, as the connector would not behave any differently in the smaller size.” (Office Action, p. 5). Applicants respectfully disagree.

As illustrated in Figure 5 of Ignatowski, and acknowledged by the Examiner, Ignatowski fails to disclose spherical end pieces which are larger in diameter than the rest of the body. Figure 5 of Ignatowski teaches a coupling member 40 attached to gripping member 20 and having decorative strands 30. Coupling member 40 is formed with apexes 41a-41c, with each apex comprising “a hole for use as an attachment point.” (Ignatowski, col. 6, ll. 11-13, 18-20). “The hole in apex 41a of the coupling member 40 attaches to the intermediate ring 26 for connection to the gripping member 20, while the holes in the other apexes 41b and 41c each connect to a single decorative strand.” (Ignatowski, col. 6, ll. 19-24). Figure 10A, also, discloses that “both strands 30 may be fixedly attached onto two different corners of the coupling member 40, and the third gripping member may likewise be fixedly attached onto a third corner.” (Ignatowski, col. 8, ll. 48-51).

Thus, a result of this Ignatowski design is a jewelry article with coupling member 40 as an attachment point for two decorative strands 30 that hang vertically and are spaced to not interfere with one another. (Ignatowski, Figure 5). Modifying, for example, the connector 40 of Ignatowski to make it "smaller in size than the end pieces" would destroy the functionality of the Ignatowski device. In particular, contrary to the Examiner's contention that "the connector would not behave any differently in the smaller size," reducing the size of coupling member 40 would hinder the connection of two decorative strands spaced not to interfere, as disclosed by Figures 5 and 10A. Reducing the size of coupling member 40 would prevent the decorative strands from hanging freely and may cause them to become entangled if they are attached too closely together. Accordingly, reducing the size of the coupling member 40 as disclosed in Ignatowski would not have been an obvious design choice, nor would one skilled in the art of medical devices have arrived at the claimed device after considering the scope and content of Ignatowski. Reconsideration is respectfully requested.

Additionally, the Examiner alleges that "making the end pieces spherical would have been a mere obvious aesthetic change in shape." (Office Action, p. 5, ll. 18-20). Applicants respectfully disagree. There is no suggestion or motivation in Ignatowski to modify its teachings in the manner proposed in the Office Action. Despite the Examiner's allegations that making the end pieces spherical is an "obvious aesthetic

change in shape," the Office Action fails to cite any indication of a suggestion or motivation for making such a change. (Office Action, p.5). Thus, for at least the reasons set forth above, a *prima facie* case of obviousness has not been properly established and one skilled in the art of medical devices would not have arrived at the claimed device after considering the scope and content of Ignatowski. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 2, 3, 6, 8, 9, 14, 28-34, 37-42, 45-48, 50-53, 56-59, 63 and 64 depend directly or indirectly from independent claims 1, 22, 36, 49 and 54, and are therefore allowable for at least the same reasons stated above regarding claims 1, 22, 36, 49 and 54. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

C. Non Analogous Art

Moreover, the obviousness rejections in the Office Action are improper because, both Katz and Ignatowski disclose articles of jewelry, neither of which is analogous to the art of medical devices. According to the M.P.E.P., a reference in a field different from that of an Applicant's invention, used as a basis for rejection, "may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a

whole.” M.P.E.P., § 2141.01(a)(I) *citing KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007).

The articles of jewelry, disclosed by both Katz and Ignatowski, are used as ornamental designs to be worn on the body. Such jewelry articles are not, however, in the field of Applicants’ endeavor. In particular, the jewelry articles, for example, are not designed to be implanted in a patient’s body canal, nor to minimize and preserve contact with the lining of the body canal. In addition, the problems or difficulties encountered in, for example, maintaining the patency of a body canal while simultaneously minimizing contact with the lining of the body canal, are significantly different than the problems associated with wearing an article of jewelry. For at least these reasons, one of ordinary skill in the art of medical devices would not have looked to the art of jewelry to make the modifications as disclosed by the Examiner, nor would one skilled in the art have arrived at the claimed device after considering the scope and content of Ignatowski and Katz. Accordingly, the rejection is improper because the art of jewelry articles is not analogous to the art of medical devices and reconsideration is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art cited against this

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application. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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